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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNIHICO MIWA	JA9-98-171	1450
26582	7590	08/11/2004	EXAMINER	
HOLLAND & HART, LLP 555 17TH STREET, SUITE 3200 DENVER, CO 80201			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 08/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/439,264

Applicant(s)

MIWA ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24th, 2004 has been entered.

Response to Amendment

2. An amendment has been filed on May 24th, 2004. In the amendment claims 1-34 have been canceled, and claims 35-41 have been added. Claims 35-41 are currently pending in the application.

Response to Arguments

3. Applicant's arguments with respect to claims 35-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 35-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wehrenberg (U.S. PG Pub No. 2003/0126445).

6. As per claim 35, Wehrenberg teaches a method of recording (*recording*) digital data (*content*) onto a medium (*DVD, 340*) using only a digital watermark (*watermark*) to control a recording process and for indicating the addition of a copy mark to the digital data (*see paragraph 0069*), comprising detecting from the digital data any digital watermark that may be electronically embedded in the digital data, wherein the digital watermark is electronically embedded in the digital data through a transformation of the digital data (*see paragraphs 0035*), if the digital watermark is detected, determining if the digital watermark specifies that a copy mark be embedded in the digital data so as to control subsequent recording of the digital data (*see paragraphs 0040-0042*), if the results of the detection and the determination indicate that subsequent recording of the digital data is to be controlled, embedding a copy mark in the digital data, scrambling the digital data together with the watermark and the copy mark using an encryption key (*see paragraphs 0040-0042*), encoding the scrambled digital data using the encryption key; and recording the scrambled and encoded digital data onto a medium so as to control subsequent copying or playback of the-digital data as a function of the copy mark (*see paragraphs 0040-0042*).

7. As per claim 36, Wehrenberg teaches a method wherein the copy mark indicates whether copying/recording of the digital data is to be stopped or continued (*see paragraphs 0043*).

8. As per claim 37, Wehrenberg teaches a method of performing playback control of digital data that is both scrambled-and encoded using a common encryption key for both scrambling and encoding, to thereby produce scrambled and encoded digital data, wherein the scrambled and encoded digital data is then recorded onto a medium, comprising reading the scrambled and encoded digital data from the medium to thereby produce read digital data, descrambling and decoding the read digital data using the common encryption key, to thereby generate descrambled and decoded digital data, detecting any digital watermark and copy mark that is electronically embedded in the descrambled and decoded digital data, wherein the digital watermark is embedded in the descrambled and decoded digital data through a transformation of the digital data, and wherein the copy mark is embedded in the descrambled and decoded digital data as a function of a content of the digital watermark, and controlling playback of the descrambled and decoded digital data using only the copy mark (*see paragraphs 0047, 0048*).

9. As per claim 38, Wehrenberg teaches a video driver card for decoding scrambled and encoded digital data wherein original digital data is both scrambled and encoded using a common encryption key comprising means for both descrambling and decoding the scrambled and encoded digital data using the common encryption key, to thereby reproduce the original digital data, means for detecting from the original digital data any digital watermark and digital copy mark electronically embedded in the original digital data, wherein the electronically embedded digital watermark is embedded in the original digital data through a transformation of the original digital data, and wherein the embedded digital copy mark is embedded in the original digital data as a function of a content of the digital watermark, and means for controlling

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inhibition of playback of the original digital data using only digital copy mark (*see paragraphs 0040-0042*).

10. As per claim 39, Wehrenberg teaches a video driver card wherein the original digital data is an MPEG stream, and wherein the means for controlling inhibition of playback includes means for determining whether or not outputting the MPEG stream is to be performed, and includes means for outputting the MPEG stream (*see paragraphs 0040, 0041, 0049*).

11. As per claim 40, Wehrenberg teaches a player for playing-back scrambled and encoded digital data that is recorded onto a medium, wherein both scrambling and encoding of the digital data is performed using a common encryption key, comprising means for reading the scrambled and encoded digital data from the medium, means for both descrambling and decoding the read digital data using the common encryption key, to thereby recover the digital data, means for detecting from the recovered digital data any digital watermark and digital copy mark that is electronically embedded in the recovered digital data, wherein the digital watermark is electronically embedded through a transformation of the digital data, and wherein the digital watermark is electronically embedded as a function of a content of the digital watermark, and means for controlling inhibition of playback of the recovered digital data using only the detected copy mark (*see paragraphs 0047-0049*).

12. As per claim 41, Wehrenberg teaches a player wherein the recovered digital data is an MPEG stream, and wherein the means for controlling inhibition of playback (d) includes means

for determining whether or not outputting of the MPEG stream is to be performed, and includes means for outputting the MPEG stream (*see 0040, 0041, 0049*).

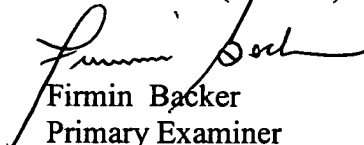
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Primary Examiner
Art Unit 3621

August 5, 2004